

**Response to Second Office Action:**

The second office action was mailed on August 31, 2005. The following are remarks directed to the rejection of the claims in the office action.

**102(b) Rejection by Stauff, US D181,884**

Claims 1-17 were rejected under 35 U.S.C. 102(b) as being anticipated by Stauff. A supportable rejection under 35 U.S.C. 102(b) requires that one reference shows all elements of the rejected claims.

Examiner states that Stauff “discloses a pack of playing cards having many of the features recited in claims 1-17. “The first indicia (numerical value) in the primary corners and secondary corners are clearly horizontally aligned with the second indicia (suit) in a region bordering the top edge and bottom edge. The judicious placement of the second indicia (suit)”...“make the playing cards **capable** of lessening the precision of vertical columnar alignment and columnar length over that obtainable with previously known packs of playing cards.” “The examiner takes the position that the term ‘horizontally proximate’ is a relative term that is open to broad interpretation.” The Examiner also states that Stauff differs in right-reading orientation and upside-down-reading orientation of second indicia, an absence of second indicia proximately below or above first indicia in secondary corners, and face cards not having split orientation central graphics that seem similar whether seen right-side up or upside down. However, Examiner holds that these differences reside in the meaning and information conveyed by printed matter and are not considered patentable

Applicant respectfully disagrees. Incorporation of elements that reside in the meaning and information conveyed by printed matter are considered patentable. Applicant agrees that a mere arrangement of printed matter, though seemingly a “manufacture,” is rejected as not being within the statutory classes of patentable subject matter if no interrelationship exists causing a function benefit to be realized by the manufacture. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA) 1969). However, when there is a functional interdependence between the printed elements being claimed and functional benefit being sought, the claim as a whole is statutory.

See MPEP 2106 IVB1(a). The judicious placement of indicia are interrelated with the pack of playing cards to permit the pack of playing card to be able to be used to accomplish a solution to the problem stated in the specification. Through the interdependence, Applicant is able to use a pack of playing cards to play columnar games with less precision of columnar alignment and with less column length than presently achievable. Because of this interdependence, the descriptive material of the printed matter must be considered.

Claim 1 states that the invention is “a pack of playing cards comprising cards having indicia in judicious placement to lessen both precision of **vertical** columnar alignment and columnar length over that obtainable with a previously known pack of playing cards – **including Stauff**. Stauff neither recognizes the problems solved by Applicant’s invention nor offers nor suggests any improvement of playing cards to lessen precision or length over that disclosed, for example, in Fig 1B of the application. As Examiner noted, Stauff teaches a second indicia in the first position having an **upside-down-reading** orientation. This would not solve the problem stated by Applicant. Some indicia, such as heart and spades could be confused in a columnar arrangement if different colors were not used. In addition, first indicia in the top secondary corner are in an **upside-down-reading** orientation. Thus, **other indicia** such as sixes and nines could be confused in a columnar arrangement.

Stauff being **capable** of permitting less precise and shorter columnar arrangements is insufficient for a rejection under 35 U.S.C. 102(b). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d.628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is not sufficient to say that a reference is **capable** of permitting a more precise and shorter columnar arrangement without some suggestion by the reference that such a modification is desirable. The Applicant’s invention has the functional property of lessening both precision of **vertical** columnar alignment and columnar length over that obtainable with a previously known pack of playing cards including those taught by Stauff. As stated in Applicant’s specification, this is a solution to a problem faced by many players of card games involving columnar card arrangements, particularly those of Bridge and Solitaire.

Two embodiments further claimed in Claim 2-7 and Claim 8-17 illustrate species that accomplish this improvement. The embodiments of Claim 2, wherein the second indicia are horizontally proximate to the first indicia, permit less precise and shorter columnar arrangements than Stauff because *second indicia are horizontally proximate or adjacent to first indicia*. Embodiments of Claim 9, claiming a broader location of the second indicia in the first position than that of Claim 2, have the additional limitation from Claim 8 that the indicia be familiar. Upside-down-reading indicia are not familiar and would be a source of confusion in columnar arrangements as previously described. Stauff does not anticipate Applicant's invention disclosed in Claim 9 because horizontally aligned second indicia in the first position in Stauff are upside-down and unfamiliar. No teaching or suggestion is made that it is important to permit right reading second indicia horizontally aligned to first indicia and proximate to the top edge of playing cards to allow for a player to discern second indicia in vertical columns with less length.

The claim limitation "horizontally proximate" cannot have a broad interpretation as suggested by the Examiner to permit Stauff to read on Claim 2 even if orientation of second indicia were not a claimable element, a position Applicant vigorously opposes. Throughout the specifications, Applicant has used proximate and adjacent interchangeably to refer to embodiments exemplified in Fig. 4. To encompass embodiments with second indicia horizontally aligned with first indicia in positions exemplified by Fig. 1A and Fig. 3, Applicant uses the language of Claim 9, "the second indicia in the first position ... being in a region bordering the top edge and extending to the right of the right-reading first indicia but not within a region proximate to the secondary corner formed by the top edge and the right edge," and Claim 12, "wherein the region bordering the top edge extends rightward from a point proximate to the right-reading first indicia to a proximate midpoint between the primary corner."

Since the cited reference does not disclose all of the elements of the claims, Applicant respectfully asks that this rejection be withdrawn for claims 1-17.

### **103(a) Rejection by Stauff US D181,884**

Claims 1-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Stauff. For an obviousness rejection to stand under 35 U.S.C. 103(a) the cited references must teach or suggest all elements of the claimed invention and there must be a motivation to combine the references.

Examiner states that “it would have been obvious for one having ordinary skill in the art at the time the invention was made to modify Stauff’s playing cards by positioning the second indicia (suits) in the first position in a right-reading orientation” bordering “the top edge and making other modifications covered by claims 10-17. These modifications would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. In *re* Gulack, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of playing card does not alter the functional relationship. *Mere support by the substrate of the printed matter is not the kind of functional relationship between the claimed printed matter ... and the substrate which is required for patentability.*”

Applicant respectfully disagrees. To establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art. In *re* Royka, 490 F.2d 981 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In *re* Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In *re* Fine, 837 F. 2d 1071, 5 USPQ2d 1596 (ed. Cir. 1988). “If the differences between the prior art and the claimed invention is limited to descriptive material on a substrate, office personnel must determine whether the material is functional descriptive material or nonfunctional descriptive material as described in MPEP 2106 IV.B.1(a) & IV.B.1(b). “Office personnel should determine whether the descriptive material is being claimed as part of an otherwise statutory manufacture. In such case, the claim remains statutory irrespective of the fact that the descriptive material is included in the claim. In contrast,

non-descriptive material is that which cannot exhibit any functional interrelationship with the performance of a manufacture.” MPEP 2106 VI.

Applicant’s descriptive material in the claims is functional. A claimed manufacture combined with descriptive elements that permit a manufacture’s functionality to be realized (1) defines structural and functional interrelationships between the manufacture and the descriptive elements and (2) is thus statutory. In Applicant’s case, the printed matter elements have a functional relationship with the article of manufacture, the pack of playing cards. As both stated and claimed, the printed matter elements permit the playing cards to be able to be less precisely vertically aligned and aligned in columns having less length. The advantages of this interrelationship are described through out the specification and include, for example, solutions to the stated needs for (1) a pack of cards to play games that involve displaying cards arranged in at least one column where playing area is limited such as, for example, some variations of Solitaire, and (2) a pack to play games that involves displaying some cards in at least one column and displaying others in a fanned arrangement such as, for example, Bridge. The solutions offered by Applicant’s invention result in stated benefits of play, some of which are (1) increased convenience and (2) the ability to play in more cramped environments.

In Applicant’s case, the descriptive elements interrelate with the manufacture (the playing card deck) to permit the playing cards to be used in columnar games with less precision of both **vertical** columnar alignment and columnar length over that obtainable with a previously known pack of playing cards. This functional interrelationship permits the ability of playing known games but in confined areas not previously possible or possible but only with *great difficulty* that can cause both physical and mental anxiety. Functional descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103. Thus, a rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art. In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999)

Since the cited references do not disclose all of the elements of the claims or show any motivation to modify the elements to resemble the claimed elements, Applicant respectfully requests that this rejection be withdrawn for claims 1-17.

### Conclusions

Because of the above remarks, Applicant respectfully requests that the present application be allowed. Should Examiner consider that any minor matters remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned to reach prompt resolution thereof.

In addition, Examiner is again requested to reconsider the restriction made earlier as he has not yet stated his reasons for making the restriction final. It is believed that no additional search would be required for the method claims as the method requires the use of Applicant's deck of playing cards.

Customer Number 44977

CERTIFICATE UNDER 37C.F.R. 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 11th day of November 2005.

Respectfully submitted,



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